



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,191	03/31/2004	Amit Bagga	503048-US-CIP (Bagga)	7508

47702 7590 08/17/2007
RYAN, MASON & LEWIS, LLP
1300 POST ROAD
SUITE 205
FAIRFIELD, CT 06824

EXAMINER

GYORFI, THOMAS A

ART UNIT	PAPER NUMBER
----------	--------------

2135

MAIL DATE	DELIVERY MODE
-----------	---------------

08/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/815,191		BAGGA ET AL.	
	Examiner		Art Unit	
	Tom Gyorfi		2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-27 remain for examination. The correspondence filed 7/25/07 amended claims 1, 21, and 27.

Response to Arguments

2. Except as discussed below, Applicant's arguments filed 7/25/07 have been fully considered but they are moot in view of the new grounds of rejection.
3. With respect to Applicant's arguments against the rejection of claim 27 under 35 USC 101, it is observed that that Applicant did not traverse the additional reasoning on page 5 of the Office Action of 4/25/07, wherein the claim was observed to lack the requisite functionality to satisfy the practical application requirement. In other words, the claim is directed to a computer-readable medium that contains a program for a computer on it; however, said computer readable medium does not actually perform or implement the method contained therein. This is confirmed by the instant specification on page 21, lines 12-24, which includes the following: "*The computer readable program code means is operable, **in conjunction with a computer system**, to carry out all or some of the steps to perform the methods or create the apparatuses discussed herein.*" (lines 15-17, with emphasis added). The claimed computer-readable medium therefore does not possess any utility in and of itself, and so the claim must be amended to account for the additional components required to realize the claimed functionality. It is additionally observed that the instant specification also allows for the computer-readable medium may be realized as non-statutory embodiments, including but not limited to the

transmission media listed on page 21, lines 19-21. These embodiments are merely signals – forms of energy – that do not conform to any of the statutory classes of invention. Moreover, the Supreme Court has read the term “manufacture” in accordance with its dictionary definition to mean “the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery.” *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 196-97 (1980) (quoting *American Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11, 8 USPQ 131, 133 (1931), which, in turn, quotes the Century Dictionary). Other courts have applied similar definitions. See *American Disappearing Bed Co. v. Arnaelsteen*, 182 F. 324, 325 (9th Cir. 1910), cert. denied, 220 U.S. 622 (1911). These definitions require physical substance, which the claimed signal embodiments do not have. Applicant is thus additionally required to amend the claim to preclude the non-statutory embodiments by stipulating that the article of manufacture be physical in nature (such as the recordable media on page 21, line 18) or, in the alternative, amend the specification to remove the non-statutory definition(s) of “computer-readable medium” from the context of the instant application.

Claim Rejections - 35 USC § 101

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 27 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is directed to an article of manufacture comprising a machine-readable medium containing one or more programs; this qualifies as software [descriptive material] *per se*, and is not recognized as statutory subject matter under current Office practice: *In re Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759. Furthermore, as the article of manufacture does not appear to be defined as any type computer or machine capable of executing the claimed program (see the instant specification, page 21, lines 12-24), thus the claimed subject matter lacks any requisite functionality to satisfy the practical application requirement, again making the claim non-statutory: *Diamond v. Diehr*, 450 U.S. at 185-186, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”) See also MPEP § 2106.01. Furthermore, the claim encompasses intangible embodiments that are non-statutory as discussed above, which do not qualify as “articles of manufacture” or any of the other statutory classes of invention. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. Claims 1-3, 7, 9, 12-22, 25, and 27 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. The "P-Synch Installation and Configuration Guide" attests to the existence of a software product called P-Synch version 6.2, describing its functionality as it was known to exist on or around May 2002.

Regarding claims 1, 21, and 27:

P-Synch discloses a method, apparatus, and article of manufacture for evaluating a password proposed by a user during an enrollment process (page 21, "5.3 Accounts on target systems") comprising: receiving said proposed password from said user (page 4, "3. Users select a new password..."); and ensuring said user cannot be correlated with said proposed password based on one or more predefined correlation rules (page 4, "4. P-Synch checks the new password..."; cf. pages 124-126, but particularly those rules on page 126 as indicated). With respect to claim 21, P-synch is installed on a server (page 28, "1. Prepare a P-Synch server..."), which inherently possesses memory and a processor coupled to said memory.

Regarding claims 2, 3, and 22:

P-Synch further discloses wherein said one or more predefined correlation rules evaluate whether that said proposed password can be [qualitatively: the password is the username; quantitatively: the password is similar to the username] correlated with said user (page 126, as indicated).

Art Unit: 2135

Regarding claims 7 and 25:

P-Synch further discloses wherein said proposed password is an identifying number (e.g. PIN number, e.g. page 6, "2.2.2 Authentication Systems").

Regarding claim 9:

P-Synch further discloses wherein said one or more pre-defined correlation rules evaluate whether said identifying number is a top N most commonly used identifying number (in the embodiment where the password is a PIN, the password history rules on pages 126 and 127).

Regarding claims 12-14:

P-Synch further discloses wherein said identifying number is a portion of a telephone number, address, or social security number (pages 83 and 200).

Regarding claim 15:

P-Synch further discloses wherein said proposed password is a word (page 125, the dictionary rules).

Regarding claim 16:

P-Synch further discloses wherein said one or more predefined correlation rules evaluate whether a correlation between said word and said user exceeds a predefined threshold (e.g. the last two rules on page 125).

Regarding claim 17:

P-Synch further discloses wherein said correlation is determined by performing a meta-search (searching in accordance with rules found in one or more external plug-ins and/or the password history table, page 126).

Regarding claim 18:

P-Synch further discloses wherein said step of ensuring a correlation further comprises the step of performing a meta-search (Ibid).

Regarding claim 19:

P-Synch further discloses wherein said step of ensuring a correlation further comprises the step of performing a local proximity evaluation (e.g. the last two rules on page 125, and the variants of the username on page 126).

Regarding claim 20:

P-Synch further discloses wherein said step of ensuring a correlation further comprises the step of performing a number classification (the digits rules: page 125).

Art Unit: 2135

7. Claims 1, 21, and 27 are additionally rejected under 35 U.S.C. 102(b) as being anticipated by the American Mathematical Society "Creating a New Account" web page (hereinafter, "AMS").

Regarding claims 1, 21, and 27:

AMS discloses a method, apparatus, and article of manufacture for evaluating a password proposed by a user during an enrollment process, comprising: receiving said proposed password from said user (page 1, last bulletpoint); and ensuring said user cannot be correlated with said proposed password based on one or more predefined correlation rules (page 2, "Don't use personal information such as your name, birthday, anniversary etc."). With respect to claim 21, the fact that the enrollment process is a computer program run from a web server (page 1, "New User Signup" and "Steps to follow", 1st bulletpoint) implies a computer inherently possessing memory and a processor coupled to said memory for implementing said program.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4-6, 8, 10, 11, 23, 24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the P-Synch version 6.2 software product of May 2002 (as evidenced by the P-Synch Installation and Configuration Guide) as applied to claims 1, 7, 21, and 25 above, and further in view of "Choosing a Good Password" (hereinafter, "Netscape").

Regarding claims 4, 6, 23, and 24:

P-Synch comprises all the limitations of claims 1 and 21 above. P-Synch further discloses wherein said proposed password is comprised of a proposed answer and a proposed hint (the user Q&A profiles on pages 83 and 199-200; cf.). Although P-Synch has many rules by which one can correlate a proposed password to known weak passwords, P-Synch does not explicitly disclose determining whether the proposed answer can be correlated to/obtained from the proposed hint (i.e. the proposed password should not be similar to any of the personal information used in establishing one's personal profile – see also page 6, "2.2.2 Authentication System"). However, P-Synch discloses that one can augment the rules by which it determines the strength of proposed passwords (via external plug-ins, page 126; cf. sections 10.19.1 and 10.19.2 on pages 127-128) developed using techniques that one of ordinary skill in the art would have known (pages 576-584), said plug-ins allowing P-Synch to query additional sources for password strength rules (ibid). Furthermore, Netscape teaches that it was common knowledge that various kinds of information already retained by P-Synch for a user's personal profile (the hints and answers), makes for very weak passwords (page

1, "Don't Use"). It would have been obvious to one of ordinary skill in the art at the time the invention was made to develop a plug-in for P-Synch, in accordance with the techniques explicitly disclosed for that exact purpose, that would have allowed it to query the user's personal profile to see if the proposed answer correlates to [e.g. is an anagram of], or can be obtained from [e.g. is an exact match for], the password hint. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by the disclosed methods, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the instant invention.

Regarding claim 5:

P-Synch further discloses wherein said particular relation is selected from the group consisting essentially of self, family member, co-author, teammate, colleague, neighbor, community member, or household member (pages 83, 199, & 200).

Regarding claims 8, 10, 11 and 26:

Although P-Synch discloses wherein said proposed password is an identifying number, it does not explicitly disclose rules to determine if the identifying number meets any of the following criteria: whether said identifying number identifies a person in a particular relationship to said user [claims 8 and 26], identifies a top N commercial entity [claim 10], or identifies said user [claim 11]. However, P-Synch maintains a database with each of those pieces of information: a number that identifies a person in a particular

relationship to said user ("Family member phone number that is not your own", pages 83 and 200), a top N¹ commercial entity (radio station dial number, Ibid), and the user ("Your SSN", Ibid). P-Synch further discloses that one can augment the rules by which it determines the strength of proposed passwords (via external plug-ins, page 126; cf. sections 10.19.1 and 10.19.2 on pages 127-128) developed using techniques that one of ordinary skill in the art would have known (pages 576-584), said plug-ins allowing P-Synch to query additional sources for password strength rules (Ibid). Furthermore, Netscape teaches that it was common knowledge that each piece of personal information known to be recorded by P-Synch makes for a very weak password (page 1, "Don't Use"). It would have been obvious to one of ordinary skill in the art at the time the invention was made to develop a plug-in for P-Synch, in accordance with the techniques explicitly disclosed for that exact purpose, that would have allowed it to query the user's personal profile to evaluate whether the identifying number meets any of the recited criteria in these claims. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by the known methods, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the instant invention.

¹ For purposes of the rejection of claim 10, it is assumed that N=1.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

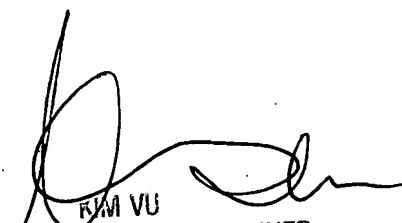
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Gyorfi whose telephone number is (571) 272-3849. The examiner can normally be reached on 8:30am - 5:00pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2135

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TAG
8/6/07


KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100